

Applicant: Michael Brier
Serial No. 09/975,495
Filed: 10/11/ 2001

REMARKS

The Office Action dated July 30, 2003 has been carefully considered. Applicant appreciates the Examiner's efforts in conducting a comprehensive examination. Applicant has amended the claims to a scope commensurate with the issues raised by the Examiner. Reconsideration is respectfully requested.

Applicant confirms the provisional election of claims 1 – 5 without traverse. Claims 6 – 7 stand withdrawn.

Claims 1, 3, and 4 have been amended. Claim 2 has been cancelled without prejudice. Claim 8 has been added. Claims 1 and 3 – 5 and 8 remain pending. No new matter has been added. Claim 1 has been amended to overcome the rejections under 35 U.S.C. §112, and is otherwise believed to be in condition for allowance as discussed herein below. Claim 8 has been added and is further believed to be in condition for allowance.

Rejections Under 35 U.S.C. §112

As to the rejections under 35 U.S.C. §112, the Examiner states that he is unable to find in the specification the disclosure of an “anti-stain substance”. Responsive, thereto Applicant notes references to the desirability of such substances in at page 1, line 12, and further in the abstract.

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Rejections Under 35 U.S.C. §103

Claims 1 – 5 were rejected under 35 U.S.C. §103 as being unpatentable over Connick, Jr. et al. (3,976,818) and independently over Vasilica (RO 109225).

U.S. Patent No. 3,976,818 issued to Connick, Jr. et al., discloses an oil-repellent, stain-release fabric treatment that renders textiles repellent to oil and water and improves anti-stain properties. Connick, Jr., however, teaches a significantly different curing technique than that claimed by Applicant. More particularly, Connick, Jr. discloses a relatively lengthy curing process using an “oven” with curing temperatures of 80° - 170° and a duration of 2 – 5 minutes. In contrast, Applicant claims a curing process wherein the fabric is attached to a tenter frame (referenced as 24 in FIG. 1) and passed through a heating chamber (26) at a much faster rate of 17 yards per minute when curing water-resistant substances (e.g. Claim 1), and a rate of 40 yards per minute when curing antimicrobial substances, at temperatures in excess of those disclosed by Connick, Jr. Accordingly, Applicant’s claimed curing process using a tenter frame is distinctly different than the “oven” process disclosed by Connick Jr. Applicant is unable to find any teaching or suggestion by Connick Jr., that curing using higher temperatures and tenter frame assembly is desirable. It is believed that Applicant’s claimed process using a tenter frame curing step is significantly more efficient than batch curing using an oven as disclosed by Connick Jr.

The reference identified as RO 109225 (Vasilica) fails to remedy the deficiencies of the Connick, Jr. reference. More particularly, Vasilica teaches a process to obtain fabrics for camouflage tarpaulin wherein an impregnated fabric is cured “by conventional drying and heat setting” at 140

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degrees for 4 minutes. Vasilica fails to either teach or suggest curing the fabric as disclosed and claimed in the present invention.

In support of the rejections under 35 U.S.C. 103(a), the Examiner relies on combinations of references. Applicant, however, is unable to find any teachings or suggestions that it would be desirable to combine the references as suggested by the Examiner. It is axiomatic that in order to justify combination of references it is not only necessary that it be physically possible to combine them, but that the art contain something to suggest the desirability of doing so. Ex parte Walker, 135 U.S.P.Q. 195 (1961). Furthermore, the Examiner must identify where the prior art provides a motivating suggestion for the combination. In re Jones, 958 F.2d 347, 21 USPQ.2d 1941 (Fed. Cir. 1992). The Federal Circuit, in In re Jones, confirmed that “[b]efore the PTO may combine the disclosures of two or more prior art references in order to establish prima facie obviousness, there must be some suggestion for doing so . . .” (citing In re Fine, 837 F.2d 1071, 1074 (Fed Cir. 1988)).

As discussed above, the various references cited by the Examiner fail to teach or suggest the presently claimed invention, either alone or in combination. In addition, the cited references fail to teach or suggest the desirability of the combined teachings relied on by the Examiner. Accordingly, the proposed combinations are improper and fail to support rejection under 35 U.S.C. § 103. See, C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 48 USPTQ.2d 1225 (Fed. Cir. 1998) (There must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination).

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It is improper to use the inventor's disclosure as an instruction book on how to reconstruct the prior art. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987).

During prosecution, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1 USPQ.2d 1593 (Fed. Cir. 1987) (A holding that claims are invalid based merely upon finding similar elements in separate prior art patents would be contrary to statute and would defeat the congressional purpose in enacting Title 35). As the Federal Circuit has often stated, "virtually all [inventions] are combinations of old elements." Environmental Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983).

Accordingly, to prevent the use of hindsight based on the invention to defeat patentability of the invention, the law requires the examiner to show a motivation to combine the references that create the case of obviousness. In Re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998). The showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing alone, is not evidence.

The Federal Circuit has identified three possible sources for a motivation to combine references: (1) the nature of the problem to be solved; (2) the teachings of the prior art; and (3) the knowledge of persons of ordinary skill in the art. Id. In the present case the Examiner relies upon none of the three possible sources for motivation. Instead, after each citation of a particular feature in the cited art, the Examiner summarily concludes that "it would have been obvious to one of

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ordinary skill in the art at the time the invention was made to modify the teaching of X by combining Y.” The Examiner has not, however, explained what specific understanding or technological principal within the knowledge of one of ordinary skill in the art would have suggested the combination. When the Examiner does not explain the specific understanding or principle within the knowledge of a skilled artisan that would motivate one with no knowledge of the present invention to make the combination, it is presumed that the Examiner selected the references with the assistance of hindsight. Id. at page 1358.

While a suggestion to combine may come from the prior art, as filtered through the knowledge of one skilled in the art, Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 43 USPQ.2d 1481 (Fed. Cir. 1997), rarely will the skill in the art operate to supply missing knowledge or prior art to reach an obviousness judgment. In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453 (Fed. Cir. 1998). If such rote invocation could suffice to supply a motivation to combine, the more sophisticated scientific fields would rarely, if ever, experience a patentable technical advance. Id.

In Ex Parte Clapp, 227 USPQ 972, claims were rejected under 35 U.S.C. §103 when the Examiner combined a number of references. The Board in Clapp set out the requirement that the Examiner state a line of reasoning as to why the artisan, viewing only the collective teachings of the references, would have found it obvious to selectively pick and choose various elements and/or concepts from the several references relied on to arrive at the claimed invention. The Board in Clapp noted that the Examiner had done little more than “cite references to show that one or more elements or sub-combinations thereof, when each is viewed in a vacuum, is known. 227 USPQ 972, 973. The

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Board held that “to support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the Examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” 227 USPQ 972, 973. The Board could not find anything in the references to expressly or impliedly teach or suggest the modifications urged by the Examiner, nor could the Board find a line of reasoning advanced by the Examiner as to why the artisan would have concluded that the modifications urged by the Examiner were obvious. The Board held that, on the record before it, “the artisan would not have found it obvious to selectively pick and choose elements or concepts from the various references so as to arrive at the claimed invention without using the claims as a guide.”

Applicants also rely on the decision of the Court of Appeals for the Federal Circuit in Carella v. Starlight Archery, 231 USPQ 644. One of the issues in Carella was the obviousness of the invention over the prior art. The CAFC noted that the Court below had acknowledged that use of vertical height for range finding, use of multiple elements on a sight and use of circular apertures were each known in the art, but concluded that the prior art lacked any teaching or suggestion to combine the separate features in a manner permitting use of circular apertures for simultaneous range finding. Obvious cannot be established by combining the teachings of the prior art to produced the claimed invention absent some teaching, suggestion or incentive supporting the combination. ACS Hospital Systems, Inc. v. Montefiore Hospital, 723 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984).

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Both Carely and Clapp stand for the proposition that the art, not the Examiner, must teach the suggested combination. Further, if the references do not expressly or impliedly suggest the claimed combination then the burden falls on the Examiner to advance a line of reasoning which supports the position advanced by the Examiner.

In Alco Standard Corp. v. Tennessee Valley Authority, 808 F.2d 1490, 1498, 1 USPQ.2d 1337, 1343 (Fed. Cir. 1986), the court stated: “the question is not simply whether the prior art ‘teaches’ the particular element of the invention, but whether it would suggest the desirability, and thus the obviousness, of making the combination.” The record does not reveal any such suggestion or teaching that would lead to the Applicants’ claimed invention.

In view of the amendments and arguments presented herein it is believed that that the claims are patentably distinguishable over the prior art. Accordingly, Applicants respectfully requests a favorable action on this case.

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Should the Examiner have any questions, comments, or concerns, the undersigned would appreciate a telephone conference in order to expedite this case.

Respectfully submitted,

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Date: 12/30/03

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